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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/748,196  | 12/31/2003  | Donald M. Berlin     | 1751.1001           | 6739             |
| 21171   | 7590        | 06/22/2006           | EXAMINER            |                  |
| STAAS & HALSEY LLP<br>SUITE 700<br>1201 NEW YORK AVENUE, N.W.<br>WASHINGTON, DC 20005 |             |                      | LE, MIRANDA         |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2167                |                  |

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/748,196

Applicant(s)

BERLIN ET AL.

Examiner

Miranda Le

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21/31/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because they fail to show necessary textual labels of features or symbols in Fig. 1 as described in the specification. For example, placing a label, "Network", with elements 172, would give the viewer necessary detail to fully understand this element at a glance. A *descriptive* textual label for *numbered elements* 174, 170 in this figure would be needed to fully and better understand these figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be shown in the drawing. Optionally, applicant may wish to include a table next to the present figure to fulfill this requirement. See 37 CFR 1.83. 37 CFR 1.84(n)(o) is recited below:

"(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the drawing, subject to approval by the Office. They should contain as few words as possible."

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

Para [0024], page 5, "forms 3, 4, 5, and 144" are not seen in Fig. 3.

Para [0029], page 8, "forms 3, 4, 5, 144" are not seen in Figs. 4A-4F.

Para [0030], page 8, "forms 3, 4, 5" are not seen in Fig. 4B.

Para [0031], page 8, "forms 3, 4, 5" are not seen in Fig. 4C.

Correction is required.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: server 172 ([0046], lines 5-8, page 12), which should be changed to server 170.

Correction is required.

### ***Claim Objections***

4. Claim 17 is objected to because of the following informalities: “the accessing” (line 11) should be changed to “an accessing”. Appropriate correction is required.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 10 fail to provide a practical application that produces tangible results, since merely “determining whether the particular source person corresponds to a particular target person in the target dataset” does not enable the usefulness to be realized. It is not until the determining (which takes place as a thought or a computation within a processor) is brought out of the mind or processor that it becomes more than an abstraction, instead being real-world and

enabling the functionality to be realized. The claims fail to recite tangible results, as the determining step is not tangible.

Claim 17 is an apparatus claim, but has the same type of issues as claims 1, 10 therefore, is rejected under similar rationale.

Claims 2-9, 11-16 are dependent upon claims 1, 10, respectively, suffer from deficiencies similar to their respective base claim, and therefore are likewise rejected.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanner et al. (US Pub. No. 20040243588).

Tanner anticipated independent claims 1, 10, 17 by the following:

**As per claim 1**, Tanner teaches a method of determining whether a non-uniquely identified name (*i.e. a person's name or a business name, [0022]*) substantially corresponds to a uniquely identified person, the method comprising:

accessing a source dataset (*i.e. a global Information Database, [0021]*) of uniquely identified persons (*i.e. unique identifying information, [0076]*), the dataset comprising records comprising, for each uniquely identified person, a source name, a source unique identifier, a source date of birth, and a source address (*i.e. a person's name, a business or company name, an entity name, in combination with location information such as city, state, or zip code; or unique numerical identification information such as a social security number, a federal tax ID number, an account number, a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055]*), ([0099]; [0131]; [0307]);

accessing a target dataset (*i.e. multiple data sources, [0021]*) of non-uniquely identified persons, the dataset comprising records comprising, for each non-uniquely identified person, a target name (*i.e. The Person/Company name filter can identify at least four types of records: a Person Name, Person Record (PNPR), in which the record has a person's name and is a person's record; Person Name, Business Record (PNBR), in which the record has a person's name but is a business record; Business Name, Business Record (BNBR), in which the record has a business name and is a business record; and Business Name, Person Record (BNPR), in which the record has a business name but is a person's record, [0180]*), a target age, and a target age-date indicating an exact or approximate date age (*i.e. the following text can be associated with an age or DOB: "age fifty", "age 51", "dob 6/8/35", "2-3-65 dob", "dob 8/68", [0198]; first name, last name, age, address, date of birth, date of information, employment, position, and other associated information, [0318]*), ([0099]; [0131]; [0138]; [0307]); and

for a particular source person in the source dataset (*i.e. a global Information Database, [0022]*), and in accordance with the accessing (*i.e. gathering information from multiple data sources into a global database, [0022]*), automatically determining whether the particular source person (*i.e. person's name, [0022]*) corresponds to a particular target person in the target dataset (*i.e. multiple data sources, [0022]*), (*i.e. filtering potential matching records and removing at least some false positives; determining positive matching records in the global information database to the inquiry requests, [0026]*), ([0099; 0131; 0138; 0307]).

**As per claim 10**, Tanner teaches a computer-implemented method of identifying a person, comprising:

given non-uniquely identified target names and target ages/addresses corresponding to target persons (*i.e. social security number, taxpayer identification number, last name, first name, spouse name, FRM, BRN, account number, sales, date, address, city, state, zip code, or other information, [0307]*), and using a comprehensive public record dataset produced by combining multiple disparate public record databases of data of a general population including the target persons (*i.e. Fair Credit Reporting Act (FCRA) and non-FCRA related data, published data, customer-supplied data, public information, and private information, [0099]*), automatically determining with substantial certainty that a target name corresponds with a particular unique individual in the general population (*i.e. generate a ranking or sequential order for the reduced or qualified list of potential matches depending upon the quality, quantitative value, or confidence level of the potential match, [0131]*), thereby identifying the person corresponding to the target name ([0138], [0021; 0076; 0055; 0180; 0198]).

As per claim 17, Tanner teaches an apparatus for determining whether a non-uniquely identified name (*i.e. a person's name or a business name, [0022]*) substantially corresponds to a uniquely identified person, the apparatus comprising:

a first storage storing (*i.e. a global Information Database, [0021]*) a source dataset of uniquely identified persons (*i.e. unique identifying information, [0076]*), the dataset comprising records comprising, for each uniquely identified person, a source name, a source unique identifier, a source date of birth, and a source address (*i.e. a person's name, a business or company name, an entity name, in combination with location information such as city, state, or zip code; or unique numerical identification information such as a social security number, a federal tax ID number, an account number, a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055], ([0099]; [0131]; [0307])*);

a second data storage (*i.e. multiple data sources, [0021]*) storing a target dataset of non-uniquely identified persons, the dataset comprising records comprising, for each non-uniquely identified person, a target name (*i.e. The Person/Company name filter can identify at least four types of records: a Person Name, Person Record (PNPR), in which the record has a person's name and is a person's record; Person Name, Business Record (PNBR), in which the record has a person's name but is a business record; Business Name, Business Record (BNBR), in which the record has a business name and is a business record; and Business Name, Person Record (BNPR), in which the record has a business name but is a person's record, [0180]*), a target age, and a target age-date indicating an exact or approximate date of the target age (*i.e. the following*



*text can be associated with an age or DOB: "age fifty", "age 51", "dob 6/8/35", "2-3-65 dob", "dob 8/68", [0198]; first name, last name, age, address, date of birth, date of information, employment, position, and other associated information, [0318]) ([0099]; [0131]; [0138]; [0307]); and*

a processing unit (*i.e. system 500, Fig. 2*), for a particular source person in the source dataset (*i.e. a global Information Database, [0022]*), and in accordance with the accessing (*i.e. gathering information from multiple data sources into a global database, [0022]*), automatically determining whether the particular source person (*i.e. person's name, [0022]*) corresponds to a particular target person in the target dataset (*i.e. multiple data sources, [0022]*), (*i.e. filtering potential matching records and removing at least some false positives; determining positive matching records in the global information database to the inquiry requests, [0026]*), ([0099; 0131; 0138; 0307]).

**As per claim 2**, Tanner teaches a method according to claim 1, wherein the automatically determining comprises matching a target identifier in the target dataset with an identifier of the particular source person when the identifier of the particular source person is available, whereby the uniquely identified particular person is determined to correspond to the particular target person (*i.e. filtering potential matching records and removing at least some false positives; determining positive matching records in the global information database to the inquiry requests, [0026]*).

**As per claim 3**, Tanner teaches a method according to claim 2, wherein the automatically determining further comprises matching the date of birth and name of the particular source person with the particular target person based on the name, the target age, and the target age-date of the particular target person, whereby the uniquely identified particular person is determined to correspond to the particular target person (*i.e. An inquiry request can include, but is not limited to, a person's name, a business or company name, an entity name, in combination with location information such as city, state, or zip code; or unique numerical identification information such as a social security number, a federal tax ID number, an account number, a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055]*).

**As per claim 4**, Tanner teaches a method according to claim 3, wherein the automatically determining further comprises matching the address of the particular source person with the address of the particular target person, whereby the uniquely identified particular person is determined to correspond to the particular target person (*i.e. An inquiry request contains at least a portion of the following information: social security number, last name, first name, spouse name, account number, address information, or other unique identifying information, [0076]*).

**As per claim 5**, Tanner teaches a method according to claim 4, wherein the automatically matching of addresses further comprises determining that the particular source person and the particular target person both have an address common to a set of current/previous addresses of

the particular source person, where the set of current/previous addresses are obtained separately from and keyed to the source dataset (*i.e. first name, last name, age, address, date of birth, date of information, employment, position, and other associated information, [0318]*).

**As per claim 6**, Tanner teaches a method according to claim 5, wherein the automatically determining further comprises determining a uniqueness of the source name of the particular source person, and based on the uniqueness, determining whether the source name corresponds to the target name of the particular target person (*i.e. The Person/Company name filter can identify at least four types of records: a Person Name, Person Record (PNPR), in which the record has a person's name and is a person's record; Person Name, Business Record (PNBR), in which the record has a person's name but is a business record; Business Name, Business Record (BNBR), in which the record has a business name and is a business record; and Business Name, Person Record (BNPR), in which the record has a business name but is a person's record, [0180]*).

**As per claim 7**, Tanner teaches a method according to claim 6, further comprising automatically finding one or more persons who have co-resided with the particular source person using another dataset (*i.e. The Person/Company name filter can identify at least four types of records: a Person Name, Person Record (PNPR), in which the record has a person's name and is a person's record; Person Name, Business Record (PNBR), in which the record has a person's name but is a business record; Business Name, Business Record (BNBR), in which the record*

*has a business name and is a business record; and Business Name, Person Record (BNPR), in which the record has a business name but is a person's record, [0180]).*

**As per claim 8**, Tanner teaches a method according to claim 7, wherein the automatically finding of one or more persons who have co-resided with the particular person is based on whether the one or more persons have lived at the particular person's source address for a predetermined period of time (*i.e. new daily grey file, [0097]*), and is based on whether the one or more persons have lived at two consecutive current/previous addresses in the set of current/previous addresses of the particular source person (*i.e. any other entity that desires to track information related to a particular person, name, [0056]*).

**As per claim 9**, Tanner teaches a method according to any of claims 1 through 8, wherein the target dataset comprises a set of officers or directors of publicly traded companies, wherein the source dataset comprises a set of potential market participants, and wherein the determining of a correspondence between the particular source person and the particular target person indicates a substantial likelihood that the particular source person is a market participant that is also an officer or director of a publicly traded company (*i.e. Fair Credit Reporting Act (FCRA) and non-FCRA related data, published data, customer-supplied data, public information, and private information, [0099]*).

**As per claim 11**, Tanner teaches a method according to claim 10, wherein the determining is based only on the target name and target age/address (*i.e. An operator could*

*select keywords, relevant phrases, or other information related to an inquiry request, and manually generate a search query for the search engine 518, or for his or her own manual search, [0265]).*

**As per claim 12**, Tanner teaches a method according to claim 10, wherein the determining is done without a key or identifier uniquely identifying the target person among the general population and by using the public record dataset to link the target person to the particular individual in the general population (*i.e. Location information can be a network address, Internet address, website, webpage, hyperlink, link, or other pointer or location information that is associated with information collected, [0269]).*

**As per claim 13**, Tanner teaches a method according to claim 12, wherein the key or identifier comprises a social security number or an identifier that serves as a proxy therefore (*i.e. business identification information, [0055, 0180]).*

**As per claim 14**, Tanner teaches a method according to claim 10, wherein the determining is based on at least one of a date of birth of the particular individual, a degree of uniqueness of the target name, and a set of previous/former addresses of the particular individual (*i.e. generate a ranking or sequential order for the reduced or qualified list of potential matches depending upon the quality, quantitative value, or confidence level of the potential match, [0131]).*

**As per claim 15**, Tanner teaches a method according to any of claims 10 through 14, wherein the target persons comprise officers or directors of publicly traded companies (*i.e. Fair Credit Reporting Act (FCRA) and non-FCRA related data, published data, customer-supplied data, public information, and private information, [0099]*).

**As per claim 16**, Tanner teaches a method according to claim 15, wherein the determining of a correspondence between the particular unique individual in the general population with the target name indicates a substantial likelihood that the particular unique individual is an officer or director of a publicly traded company (*i.e. generate a ranking or sequential order for the reduced or qualified list of potential matches depending upon the quality, quantitative value, or confidence level of the potential match, [0131]*).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham, can be reached on (571) 272-7079. The fax number to this Art Unit is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

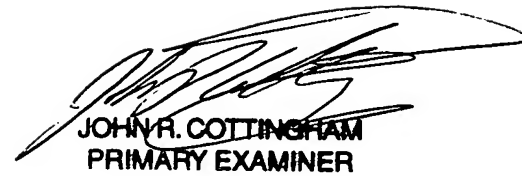
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/748,196  
Art Unit: 2167

Page 14



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June 05, 2006



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